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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,382	04/20/2001	Harry D. Danforth	0100.00	9258

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EXAMINER

HINES, JANA A

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 06/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,382

Applicant(s)

DANFORTH ET AL.

Examiner

Ja-Na A Hines

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on April 20, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-2 are drawn to an immunovariant strain of *Emieria maxima*-I, classified in class 435, subclass 258.4.
 - II. Claims 3,5,7-8,and 10 are drawn to a vaccine for use in combating coccidiosis in chickens comprising a concentration of oocysts of *E.maxima*-I, classified in class 424, subclass 271.1.
 - III. Claims 4, 6-7, 9 and 11 are drawn to a to a vaccine for use in combating coccidiosis in chickens comprising a concentration of oocysts of an immunovariant strain *E.maxima*-I, classified in class 424, subclass 267.1.
 - IV. Claims 12-13 are drawn to a method of obtaining an immunovariant strain of *E. maxima* from *E. maxima* FL strain, classified in class 530, subclass 388.6. **It is presumed that claim 13 should be dependent on claim 12, not claim 10, if so appropriate correction is required.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I and II or III are related as different products. The products are distinct as claimed because they have different structures and different uses. Group I is drawn to an immunovariant strain of *E. maxima*; Group II is drawn to a vaccine comprising oocysts; while group III is drawn to a vaccine comprising oocysts of an immunovariant strain *E.maxima*-I. Each group has a different effect and is capable of

use without the other. For instance, the *E. maxima* strain product of Group I can be used in a method to detect *E. maxima* infection however the products of Group II and III could not. While Group II and Group III are drawn to vaccines, Group III requires the use of oocysts from an immunovariant strain, whereas Group II does not; thus the groups comprise different components, thereby resulting in different effects and capable of separate use. Each group has a different structure, requires different components, produces different effects and is capable of different functions as compared to the other group. Therefore, the products of the inventions are distinct as claimed.

4. Inventions IV and I-III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, Group IV is drawn to a method of obtaining an immunovariant strain of *E. maxima* from *E. maxima* FL strain. No other the other products are drawn to the FL strain, thus the process can be used to make another and materially different product when compared to the strains or vaccines of Groups I-III. Moreover, this method would not create an immunovariant strain of *E. maxima*-I. Therefore the inventions are distinct.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
6. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II-IV, restriction for examination purposes as indicated is proper.
7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ja-Na A Hines whose telephone number is 703-305-0487. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on 703-308-3909. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Ja-Na Hines *JN*
June 2, 2002

Patricia A. Duffy
PATRICIA A. DUFFY
PRIMARY EXAMINER